REMARKS

Claims 1-25 are currently pending. The present reply is submitted in response to the Office Action dated May 24, 2006. In the Office Action, the Examiner rejected claims 1-14, 18-20, and 22 under 35 U.S.C. § 103(a) as being unpatentable over Conner (2005/0194453) in view of Roberts (U.S. Patent No. 6,025,283). In addition, claims 15-17 were rejected under 35 U.S.C. 103(a) as being upatentable over Conner, modified by Roberts, and further in view of Kaminsky (2004/0121257). Claim 21 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Conner, modified by Roberts, and further in view of Hinata (2003/0202151). Claims 23-24 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Conner, modified by Roberts, further in view of Makishima (U.S. Patent No. 3,468,046) and Biller (2003/0150762). Finally, claim 25 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Conner, modified by Roberts, further in view of Hara (U.S. Patent No. 4,876,441). New claims 26-29 have been added to the present application.

35 U.S.C. § 103(a)

With respect to the rejection of independent claim 1 under 35 U.S.C. § 103(a) as being unpatentable over Conner et al. in view of Roberts, Applicants respectfully submit that the claims, as amended, define the invention over Conner et al., Roberts, or any other cited reference of record, taken alone or in combination. More specifically, independent claim 1 defines "a first layer of metal selected from the group consisting of titanium and stainless steel card, wherein said first layer of metal has a thickness of at least 8 mils."

Neither Connor et al. nor Roberts teaches or discloses a transaction card having a thickness of at least 8 mils. Specifically, Connor et al. only discloses metal layers having a thickness of up to 6 mils. *See* Connor et al., p. 5, ¶¶81-82. In addition, Roberts, while not

disclosing titanium or stainless steel and only disclosing "precious metals," teaches cards having a precious metal "such as gold. . . . The gold layers are each 200 microns thick." Col. 4, ll. 3-5. 200 microns is equivalent to 7.8 mils.

Moreover, as the Examiner acknowledges, Conner does not suggest a first metal layer comprising embossed characters. Roberts discloses a card having a precious metal layer such as gold, silver, or platinum. The Examiner asserts that titanium is considered a precious metal, and thus it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of Roberts to the metal layer of Conner. Applicants respectfully submit that titanium and stainless steel are not precious metals. Moreover, teaching gold, silver, or platinum does not suggest titanium or stainless steel to one of ordinary skill in the art. Therefore, Applicants' invention is patentable over Conner et al. in view of Roberts.

The Federal Trade Commission defines "precious metals" as "gold, silver, and platinum group metals." 16 C.F.R. § 23. Precious metals are generally defined by their rarity and high economic value. Moreover Roberts teaches "precious metal...includ[ing] high value metals such as platinum, gold (at all carats) and silver." (col. 1, ll. 47-48) Applicant observes that titanium or stainless steel are neither rare, nor do they have inherent high economic value. Titanium is the ninth most abundant element in the Earth's crust. Although titanium is used in jewelry, it is more commonly found in a wide variety of consumer products, such as paint, toothpaste, and sunscreen, as a pigment known as titanium dioxide. Titanium and stainless steel also have a large number of industrial applications, such as airplane and automobile chassis. Due to its abundance, titanium is not commonly used as a form of currency. Gold, silver and platinum are rare and have inherent economic value, thus they may be used as currency and to hold value. Accordingly, each metal has been assigned an ISO 4217 currency code. In contrast, neither

titanium nor stainless steel has been assigned an ISO 4217 currency code. For these reasons alone Applicants believe titanium and stainless steel are not "precious metals" in the same group as gold, silver, and platinum.

In further support of patentability over Conner et al. in view of Roberts, Applicants note that titanium's and stainless steel's high strength-to-weight ratio and tensile strength further differentiates them from gold, silver, and platinum. Gold, silver, and platinum are heavy, soft and/or malleable metals. A sheet of soft, malleable metal is easily embossed. In contrast, titanium and stainless steel are relatively lightweight, hard, and exceptionally strong. Titanium and stainless steel are much harder materials. The strength and hardness of titanium and stainless steel make embossing difficult. Thus, by teaching an embossed gold, silver, or platinum layer, Roberts does not suggest titanium or stainless steel.

Moreover, Roberts teaches a flexible card, one that is "sufficiently elastic to allow a surprisingly high degree of deformation" and has a "considerable degree of flexibility." (col. 2, lines 4-5 and lines 17-18) A card utilizing a layer of titanium or stainless steel would neither be considerably flexible nor surprisingly deformable. To the contrary, the same properties that make titanium and stainless steel difficult to emboss also makes them difficult to bend. Thus, Roberts must be read to teach away from strong and relatively inelastic metals such as titanium and stainless steel.

Connor et al. actually teach away from motivating one of ordinary skill in the art to look to Roberts for providing embossed characters. Specifically, Connor et al. acknowledges that there are no embossed characters on the card (*See* Connor et al., p. 4, ¶77), and solves this by making the top layer plastic, and thereby embossing the plastic. *See id.* at ¶80.

Since Conner et al. and Roberts fail to teach or suggest the elements defined in amended independent claim 1, the rejection thereto has been overcome and, respectfully, should be withdrawn.

Claims 2-25 depend from independent claim 1. These claims are further believed allowable over the references of record for the same reasons set forth above with respect to their parent claims, since each sets forth additional structural elements of Applicants' novel transaction card.

CONCLUSION

In view of the foregoing remarks and amendments, Applicants respectfully submit that all of the claims in the application are in allowable form and that the application is now in condition for allowance. If, however, any outstanding issues remain, Applicants urge the Examiner to telephone Applicants' attorney so that the same may be resolved and the application expedited to issue. Applicants respectfully request the Examiner to indicate all claims as allowable and to pass the application to issue.

Respectfully submitted,

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